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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,330	05/20/1998	TORU NAKAMURA	514420-3596	5116

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EXAMINER
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NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.


<b>Notification of Non-Compliant Appeal Brief (37 CFR 41.37)</b>	<b>Application No.</b> 09/000,330	<b>Applicant(s)</b> NAKAMURA ET AL.	
	<b>Examiner</b> Janis L. Dote	<b>Art Unit</b> 1756	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 20 June 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file a complete new brief in compliance with 37 CFR 41.37 within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☒ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):  
see the attached.

  
**JANIS L. DOTE**  
PRIMARY EXAMINER  
GROUP 1559  
1700

Art Unit: 1756

1. The appeal brief filed on Jun. 20, 2005, is not in compliance with the requirements of 37 CFR 41.37(c) for the following reasons:

**Item 4:** In the "Summary of the claimed subject matter" section, the brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal and for each dependent claim argued separately, referring to the specification by page and line number, and to the drawing, if any, by reference characters; and/or does not identify the structure, material, or acts described in the specification as corresponding to each claimed function for every means plus function and step plus function for each independent claim involved in the appeal and for each dependent claim argued separately by reference to the specification by page and line number, and to the drawing, if any, by reference characters, as required by 37 CFR 41.37(c) (1) (v).

The following example is not exhaustive: with respect to the subject matter recited in independent claims 16, 26, and 28, the brief refers to the specification "at pages 3, 4, 7, and in particular the last paragraph of page 4 for the binder resin, and the third full paragraph at page 7 for the colorant." The

Art Unit: 1756

brief fails to indicate the disclosure relied on pages 3, 4, and 7, by line numbers, e.g., page 4, lines xx-yy.

**Item 6:** (1) The brief separately describes the subject matter recited in instant dependent claim 29, but fails to present separate arguments for that claim in the "Argument" section. Claim 29 is listed in the subheading "Claims 26, 27, and 29." (The examiner notes that dependent claim 29 does not depend from claim 26; it depends from claim 28.)

Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. Any claim argued separately should be placed under a subheading identifying the claim by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. See 37 CFR 41.37(c)(1)(vii).

(2) In the "Argument" section, under the subheading "Claims 26, 27, and 29," the brief includes claim 30, which is not listed in the subheading. See the brief, page 13, line 19. The examiner notes that the brief presents separate arguments for claim 30 under the heading "Claim 30" at page 14, of the brief.

Art Unit: 1756

(3) In the "Argument" section, the brief improperly places the subheading "Claims 16, 21, 24, and 25" before the separate heading "Rejection of Yoshikawa combined with Minami, as evidence [sic] by the *Aldrich* and *Polymer*." The subheading "Claims 16, 21, 24, and 25" should be placed below the heading "Rejection of Yoshikawa . . . ."

**Item 7:** In the "Claims Appendix," claim 26 includes the typographic error "cyclohexane" (emphasis added) that was corrected in the amendment filed on Apr. 22, 2005, and entered upon the filing of the brief. The correct term is "cyclohexene" (emphasis added).

**Other:** In the Table of Contents, the brief erroneously lists the heading "VIII. Conclusion." There is no "Conclusion" section in the brief.

The examiner notes that the headings "VIII. Conclusion" is also not a proper heading under 37 CFR 41.37(c).

37 CFR 41.37(c) states that the "brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section . . . (i) *Real party of interest* . . . (ii) *Related appeals and interferences* . . . (iii) *Status of claims* . . . (iv) *Status of amendments* . . . (v) *Summary of claimed subject matter* . . . (vi) *Grounds of rejection* . . . (vii) *Argument* . . . (viii) *Claims appendix* . . . (ix) *Evidence appendix* . . . (x) *Related proceedings appendix* . . . ."